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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,880	03/31/2004	Vecraraghavan Srinivasan	147201-1	9067
43248	7590	10/10/2006		
CANTOR COLBURN LLP - GE PLASTICS - SMITH 55 GRIFFIN RD SOUTH BLOOMFIELD, CT 06002			EXAMINER WOODWARD, ANA LUCRECIA	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,880

Applicant(s)

SRINIVASAN ET AL.

Examiner

Ana L. Woodward

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/20/2004, 6/03/2005, 2/24/2006, 4/20/2006
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final. 7/20/2006
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
4a) Of the above claim(s) 1-24, 28, 29, 39, 40, 42-55, 57, 58 and 76 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 25-27, 30-38, 41, 56 and 59-75 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/20/04, 6/03/05, 2/24/06
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group II comprising polycarbonates, manufactured by melt transesterification formed by reacting a carbonic acid diester and a 2-hydrocarbyl-3,3-bis(4hydroxyaryl)phthalimidine in the presence of a catalyst, as the ultimate species of polymer in the replies filed on April 20, 2006 and July 20, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 1-24, 28, 29, 39, 40, 42-55, 57, 58 and 76 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 20, 2006.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 1711

5. Claims 25-27, 30-38, 41, 56, 59-69 and 72-75 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 5,344,910 (Sybert).

Sybert discloses polycarbonate resins containing repeating or recurring units of 2-alkyl-3,3-bis(p-hydroxyphenyl)phthalimide. The polycarbonate is produced via an interfacial polymerization method comprising the reaction of a dihydric monomer of formula (II), which corresponds to the presently claimed 2-hydrocarbyl-3,3-bis(4-hydroxyaryl)phthalimidine, a dihydric phenol and a carbonate precursor, such as phosgene, in aqueous caustic and in the presence of a suitable catalyst. See exemplified polycarbonates and comparative products comprising 2-phenyl-3,3-bis(p-hydroxyphenyl)phthalimide units.

The disclosure of the reference meets the requirements of the present claims in terms of the types of materials added and method of preparation. Given the similarity in chemical makeup and method of preparation, it is reasonably believed that the product of the reference would inherently meet all properties, e.g., coloration, governing the presently claimed product. Furthermore, the reference is silent as to the presence of the presently recited impurities and, as such, it is reasonably believed that the product of the reference would necessarily meet the presently claimed limitation of "less than or equal to 1,000 parts per million". The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

Claims 33-38 and 41 have been incorporated into the rejection because claim 33 does not require the melt transesterification polymerization process.

Art Unit: 1711

6. Claims 25-27, 30 and 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 3070790.

JP '790 discloses a polyether-based polymer comprising the presently claimed structural units. The disclosure of the reference meets the requirements of the present claims, as presently recited. The reference is silent as to the presence of the presently recited impurities and, as such, it is reasonably believed that the product of the reference would necessarily meet the presently claimed limitation of "less than or equal to 1,000 parts per million". The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

Claim Rejections - 35 USC § 103

7. Claims 70 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,344,910 (Sybert) described hereinabove in view of U.S. 5,910,562 (Miura et al).

It would have been obvious to one having ordinary skill in the art to have utilized the polycarbonate composition of Sybert in the production of optical devices such as lenses. In this regard, attention is directed to the teachings of Miura et al for the conventionality of producing optical articles such as plastic lenses from polycarbonates.

Claim Rejections - 35 USC § 112

8. Claims 60-64 and 73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 60 and 64, there is no express antecedent basis for "said activated carbonate".

In claim 61, line 6, there is no express antecedent basis for "R1".

Art Unit: 1711

In claim 61, last line, it is unclear what “when n is 1” is referring to.

In claim 61, last line, “and n has a value of 0 or 1” appears to conflict with the antecedently recited “n is a natural number of 1...”.

In claim 73, the recited subject matter is not further limiting.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10 Claims 25-27, 30-38, 41, 56 and 59-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18 and 19 and 25-29 of copending Application No. 11/300,225. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims generically encompass the polymer claimed in the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1711

11. Claims 25-27, 30-38, 41, 56 and 59-75 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-8 of copending Application No. 11/263,132. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claims generically encompass the polymer claimed in the copending application.

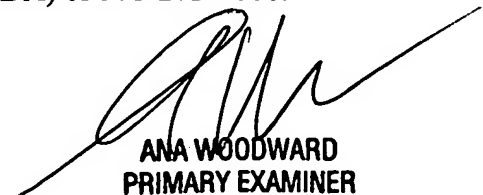
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


ANA WOODWARD
PRIMARY EXAMINER